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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/099,959 | 03/19/2002 | Yassin M. Elgarhy | 12676-15US-1 | 9063 |

20988 7590 10/22/2003

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| EXAMINER | |
|---|---|
| GUARRIELLO, JOHN J | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1771 | |

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/099,959 | ELGARHY, YASSIN M. | |
| | Examiner | Art Unit | |
| | John J. Guarriello | 1771 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *15-33* is/are pending in the application.

4a) Of the above claim(s) *24-31* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *15-23, 32, 33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## **DETAILED** ACTION

### *Election/Restriction*

15 Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 15-23, 32, 33 drawn to aqueous formulation composition, classified in class 528, subclass 129.

II. Claims 24-31, drawn to method of applying, classified in class 8, subclass 115.54.

16. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product can be practiced with another materially different product such as condensates in an alkaline media with pH conditions adjusted to prevent yellowing.

17. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

18. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

19. During a telephone conversation with Kevin Murphy on 10/16/2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 15-23, 32, 33. Affirmation of this election must be made by applicant in replying to this Office action. Claims 24-31, Group II are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

20. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

21. Claims 15-18, 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 15, lines 13-15, it is not clear what "high weight average molecular weight and high number average molecular weight" encompasses since the terms "high" are relative terms and the meaning varies from polymer to polymer. In line 13, "semi-soluble" is not clear since no degree of specificity of solubility is described in the specification for the methacrylic acid polymer.

In claim 15, line 13, it is not clear what the phrase "semi-soluble" encompasses since the specification does not indicate any degree of solubility of the ethyl methacrylate polymer.

***Claim Rejections - 35 USC § 102***

22. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Elgarhy et al. 5,457,259.

Elgarhy describes a treated fibrous polyamide substrate having durable resistance to staining, (see abstract). Elgarhy describes an aqueous solution of a partially sulfonated, partially phosphated resol resin which aqueous solution may include polymethacrylates, (see abstract). Elharhy describes the condensation products of naphthalene sulfonic acid and dihydroxydipheny sulfone with

formaldehyde which are used to treat fibrous substrates, (column 1, lines 45-68; column 2, lines 15-51). Elgarhy describes fluorochemicals which can be applied, (column 7, lines 7-9). Elharhy describes the essential limitations of the claimed invention. Claims lack novelty.

23. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Elgahary 5,736,468.

Elgahary describes a treated fibrous polyamide substrate having durable resistance to staining, (see abstract). Elhahary describes an

aqueous solution of a sulfonated, phosphated resol resin with a methacrylic polymer or copolymer having a number average molecular weight in the range of 20,000 to 40,000, (column 3, lines 1-7). Elgarhy describes condensation product of naphthalene sulfonic acid with an aldehyde, (column 3, lines 28-64), which are used to treat fibrous polyamide substrate. Elgarhy describes fluorochemicals which can be applied, (column 7, lines 7-9). Elgarhy describes the essential limitations of the claimed invention. Claims lack novelty.

***Claim Rejections - 35 USC § 103***

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a

person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

25. Claims 32, 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elgarhy et al. 5,457,259.

Elgarhy describes the treating of fibrous polyamide substrates as above in paragraph # 22 but differs because it does not state the high number average molecular weight of the methacrylic polymer.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the number average molecular weights of Elgarhy motivated with the expectation that this is routine in this art of treating of fibrous substrates since it is known that adjusting ratios of components can be expected to show improvement of results of improving discoloration properties, (column 2, lines 15-24), see In re Aller, 105 USPQ 233.

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 32, 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elgarhy 5,736,468.

Elgarhy describes the treating of fibrous polyamide substrates as above in paragraph # 23, but differs because it is silent about the high number average molecular weight of the methacrylic polymer.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the number average molecular weights of Elgarhy motivated with the expectation that this is routine in this art of treating of fibrous substrates, since it is known that adjusting ratios of components can be expected to show

improvement of the results of improving discoloration properties, (column 2, lines 32-41), **see In re Aller, 105 USPQ 233.**

***Double Patenting***

27. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

28. Claims 15-23, 32, 33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 5,756,407. Although the conflicting claims are not identical, they are not patentably distinct from each

other because it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the treating solution of the mixture of '407 by optimizing the appropriate molecular weights, pH and other conventional factors motivated with the expectation that since '407 suggests a treating solution with a sulfonated resol resin with a methacrylic polymer or copolymer with overlapping values, see claims 1-10, it would be routine to optimize the amounts of the components see In re Aller, 105 USPQ 233.

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Guarriello whose telephone number is (703) 308-3209. The examiner can normally be reached on Monday to Friday from 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

John J. Guarriello:gj

Patent Examiner

October 16, 2003

TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700